

## REMARKS

The Examiner noted the restriction requirement and the applicant's provisional election of Claims 1-13 for prosecution in this case. Accordingly, the applicant has cancelled Claims 14-34, without prejudice.

The Examiner rejected Claims 1-13 under 35 U.S.C. 112, second paragraph, as indefinite because Claim 1 did not establish an initial direction of fluid flow through the electrode aperture. Therefore, the step of reversing the direction of fluid flow through the electrode aperture was found to be indefinite. In order to clarify the claim, the language "reversing the direction of fluid flow ..." has been replaced with "--inducing fluid flow from the extracellular compartment into the intracellular compartment through the electrode aperture ... ." It is believed that this language clearly recites the same concept without possibility of misinterpreting the claim limitation.

The Examiner rejected Claims 1, 2, 8, 9, 12 and 13 under 35 U.S.C. 103(a) as rendered obvious by the Kostyuk article (Nature, 257:691-693, 1975) in view of Rubinsky et al (U.S. Patent 6,300,108). The Examiner also indicated the allowability of Claims 3-7 if rewritten to overcome the Section 112 rejection

and to include all limitations of the claims from which they depend.

In view of the foregoing, the applicant is cancelling Claims 1 and 2, without prejudice, and has rewritten Claims 3 and 6 in independent form, including the change described above to address the indefiniteness rejection. Claim 7 has been amended to conform to this change in the language of Claim 6, from which it depends. When applicable, the other claims have been amended to depend from an allowable claim.

These amendments are believed to place in condition for allowance all claims that remain pending from the claims originally filed with the application. In addition, new Claims 35-40 have been added to recite the same limitations of Claims 7-12 (which depend from allowable Claim 6) with respect to allowable Claim 3.

The applicant is also submitting new Claims 41-47 for the Examiner's consideration. Claim 41 is identical to allowed Claim 6, except that the language "wherein said step of preventing flow ... is performed by applying pressure to the intracellular compartment" is changed to --... is performed by inducing fluid flow from the intracellular compartment into the extracellular compartment through said electrode aperture.-- Inasmuch as this aspect of the invention is clearly based on

providing upward flow of intracellular solution to prevent downward flow of extracellular solution and to keep debris out of the aperture, the broader language of Claim 41 is believed to be fully supported by the specification of the invention and consistent with the reasons for allowance indicated by the Examiner. The minor change from the language of allowed Claim 6 will afford the applicant a scope of protection appropriately commensurate with the invention. According, the applicant and the undersigned respectfully request consideration and urge the allowance of this new claim. Claims 42-47 recite additional limitations in a line of dependent claims consistent with the other dependent claims.

In view of the foregoing, all pending claims are believed to recite allowable subject matter. The applicant and his attorney thank the Examiner for the thorough examination of the application.

No additional filing fees are believed to be due because the total number of pending claims (24) and of independent claims (3) is lower than originally filed (34 and 6, respectively). Please charge any other cost associated with this transmittal to our Deposit Account No. 17-0055.

Respectfully submitted,



Antonio R. Durando  
Reg. No. 28,409

(520) 770-8760 phone  
(520) 770-2236 fax